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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,756	11/01/2001	Carsten Schuh	P99,0663-01	8592

7590 02/11/2004

SCHIFF HARDIN & WAITE  
Patent Department  
6600 Sears Tower  
233 South Wacker Drive  
Chicago, IL 60606

EXAMINER
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NGUYEN, DONGHAI D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 02/11/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/003,756

Applicant(s)

SCHUH ET AL.

Examiner

Donghai D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/295,917.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: the phrase "09/295,917, filed" (in the pre-Amendment A, line 2) should be --09/295,917, now Abandoned, filed--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 5, 7, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,314,302 to Baumbach.

Regarding claims 1 and 11, Baumbach discloses a method for producing an electrical or electronic component, the method comprising the following steps: providing a plastic body (4/6) for accommodating and encapsulating the surface of the component (18), inserting the component into the plastic body (Fig. 1), joining the surface of the component to the plastic body by applying pressure to the plastic body (Figs. 5-6 and col. 2, lines 29-44).

Regarding claims 3 and 5, see Fig. 1

Regarding to claim 7, the body 4 or 6 is having a stabilizing element (it has a resilient characteristic, see col. 2, line 4).

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4. Claims 1-5 and 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,148,077 to Grawey et al.

Regard to claims 1 and 11, Grawey et al disclose a method for producing an electrical or electronic component, the method comprising the following steps: providing a plastic body (220/222/224) for accommodating and encapsulating the surface of the component (202), inserting the component into the plastic body (Fig. 2), joining the surface of the component to the plastic body by applying pressure to the plastic body (col. 5, lines 29-33).

Regarding claims 2 - 4, see figs. 1-2.

Regarding claim 5, Grawey et al disclose the body comprises at least two individual parts (224 and 222), which are connected to the surface of the component.

Regarding claim 7, Grawey et al disclose the body comprises at least one stabilizing element (Col. 6, lines 35-39).

Regarding claims 8 and 9, Grawey et al disclose the body comprises a substance for mediating adhesion and the surface of the component comprises a substance for mediating adhesion (222).

Regarding to claim 10, Grawey et al disclose the body comprises at least one plastic that is selected from the group consisting of solid silicones and fluorinated silicone elastomer (Col. 2, lines 56-63).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grawey et al in view of Applicants' Admitted Prior Art.

Grawey et al disclose al the claimed invention of producing the electronic or electrical component except the body comprises at least partially cross-linked plastic and the pressure is generated by the cross-linking of the plastic of the body which is cross-linked thermally or by exposure for improving the elasticity of the silicon elastomer (See Spec page 2, line 25 to page 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Grawey et al to have the body comprising cross-link plastic by thermally or exposure as taught by Admitted Prior Art for improving the elasticity of the silicon elastomer.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

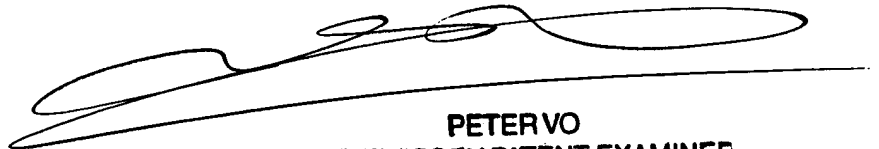
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (703) 305-7859. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN

A handwritten signature in dark ink, appearing to read 'PETER VO', with a long horizontal line extending from the end of the signature.

**PETER VO**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**